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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,631	03/26/2001	Mark J. Koch	SMQ-028	6886
959	7590	09/22/2004	EXAMINER	
LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109			DINH, MINH	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/817,631	Applicant(s) KOCH, MARK J.	
	Examiner Minh Dinh	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/12/2003</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 1-29 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19, 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Regarding claim 19, it recites the limitation "said new cipher" in the 13th line. There is insufficient antecedent basis for this limitation in the claim. The limitation is interpreted as "said cipher". Claims that are not specifically addressed are rejected to by virtue of their dependencies.

- b. Regarding claim 23, it claims "a medium for use with a computer network ... said method comprising the steps of:" (preamble). It is not clear what is claimed. For examination purpose, the claim is interpreted as a computer readable medium containing instructions for executing the steps recited in the body of the claim. Claims that are not specifically addressed are rejected to by virtue of their dependencies.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 11-12, 23, 26 and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Spies et al. (6,055,314).

a. Regarding claims 11-12, 23 and 28-29, Spies discloses a method for delivering digital media content, said method for use with a network, said network interfaced with a storage medium containing digital media content and further interfaced with an electronic device, said electronic device interfaced with a smart card equipped with a license for said digital media content, said method comprising the steps of:

 sending a request for said digital media content over said network from said electronic device (fig. 10, step 310);

 receiving a stream of said digital media content in encrypted form from said medium with said electronic device, said encrypted digital media content being stored on said electronic device (fig. 11, step 322);

 extracting a cipher from said digital media content and sending said cipher to said smart card fig. 12, (fig. 12, steps 332-334);

 obtaining a decryption key for said cipher, said decryption key being transmitted from said smart card to said electronic device (fig. 12, steps 332-334); and

using said decryption key and a decryption algorithm located on said electronic device to decrypt said digital media content stored on said electronic device (fig. 12, step 338).

presenting said digital media content to said user (fig. 12, step 340).

- b. Regarding claim 26, Spies further discloses that said digital media content has both audio and visual components (see Abstract).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedemer (4,908,834) in view of Spies.

- a. Regarding claim 1, Wiedemer discloses a method for delivering digital media content, said method for use with a network, said network interfaced with a storage medium containing digital media content and further interfaced with an electronic device, said electronic device interfaced with a removable memory module equipped with a license for said digital media content, said method comprising the steps of:

receiving a stream of said digital media content in encrypted form from said medium with said electronic device, said encrypted digital media content being stored on said electronic device (fig. 3, step 52);

extracting a cipher from said digital media content, said cipher being combined with a second cipher produced by said electronic device and sending the combined cipher to said removable memory module (fig. 3, steps 60-62);

obtaining a decryption key for said combined cipher, said decryption key being transmitted from removable memory module to said electronic device (fig. 3, step 64);
and

using said decryption key and an embedded key located on said electronic device to decrypt said digital media content stored on said electronic device (fig. 3, steps 70-80).

Wiedemer does not disclose sending a request for said digital media content over said network from said electronic device and using a smart card. Spies discloses a method for delivering digital media content, which includes the step of sending a request for digital media content over a network from an electronic device (fig. 10, step 310) and uses a smart card (fig. 3, element 54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wiedemer method to include the step of sending a request for said digital media content over said network from said electronic device and use a smart card, as taught by Spies. The request provides the cable company with payment instructions defining how the subscriber desires to pay for the rental program rental (col. 15, lines 42-50). Regarding

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to using a smart card, purchased decryption capabilities can be utilized without being exposed to the viewer or video computing device (col. 2, lines 35-41).

b. Regarding claim 2, Wiedemer further discloses presenting said digital media content to said user (fig. 2, element 15).

c. Regarding claims 3-4, Wiedemer does not disclose limiting said license to said digital media content so that said decryption key stops working after a pre-defined number of uses or a pre-defined period of time. Spies discloses limiting a license to a digital media content so that a decryption key stops working after a pre-defined number of uses or a pre-defined period of time (col. 8, lines 33-36; col. 9, lines 32-38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wiedemer method to include the step of limiting said license to said digital media content so that said decryption key stops working after a pre-defined number of uses or a pre-defined period of time, as taught by Spies, in order to limit the conditions of decryption.

d. Regarding claim 9, Wiedemer further discloses that said digital media content has both audio and visual components (see Title).

8. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedemer in view of Spies as applied to claim 1 above, and further in view of Digital Audio-Visual Council ("Description of Digital Audio-Visual Functionalities"). Wiedemer and Spies do not disclose denoting as reference points on said smart card each place in said stream of digital media content where said user or each one of a plurality of users

has stopped receiving said digital media content. Digital Audio-Visual Council discloses denoting as reference points each place in a stream of digital media content where said user or each one of a plurality of users has stopped receiving said digital media content (p. 31, see Section 8.2.5.2 Functions). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Wiedemer and Spies to include the step of denoting as reference points each place in said stream of digital media content where said user or each one of a plurality of users has stopped receiving said digital media content, as taught by Digital Audio-Visual Council, in order to provide a time-out whenever a session is temporarily inactive. Accordingly, this session management function is provided by said smart card.

9. Claims 7-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedemer in view of Spies as applied to claim 1 above, and further in view of Handelman et al. (6,298,441). Wiedemer and Spies do not disclose that said digital media content is audio, video or text. Handelman discloses a method for delivering digital media content, which can be audio, video or text (col. 13, lines 22-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Wiedemer and Spies such that said digital media content is audio, video or text, as taught by Handelman. These digital content types are distributable and storable in electronic form.

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10. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spies as applied to claim 11 above, and further in view of Digital Audio-Visual Council. Spies does not disclose denoting as reference points on said smart card each place in said stream of digital media content where said user or each one of a plurality of users has stopped receiving said digital media content. Digital Audio-Visual Council discloses denoting as reference points each place in a stream of digital media content where said user or each one of a plurality of users has stopped receiving said digital media content (p. 31, see Section 8.2.5.2 Functions). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Wiedemer method to include the step of denoting as reference points each place in said stream of digital media content where said user or each one of a plurality of users has stopped receiving said digital media content, as taught by Digital Audio-Visual Council, in order to provide a time-out whenever a session is temporarily inactive. Accordingly, this session management function is provided by said smart card.

11. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuria et al. (6,499,103) in view of Chaney (6,035,037) and Spies.

a. Regarding claim 15, Tsuria discloses a method for delivering digital media content, said method for use with a network, said network interfaced with a storage medium containing digital media content and further interfaced with an electronic device, said electronic device interfaced with a first smart card equipped with a license

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for said digital media content and further interfaced with a second smart card, said method comprising the steps of:

receiving a stream of said digital media content in encrypted form from said medium with said electronic device, said encrypted digital media content being stored on said electronic device (figures 2B and 8);

extracting a cipher from said digital media content and sending said cipher to said first and second smart cards (col. 1, lines 43-46; col. 14, lines 12-37);

obtaining a first decryption key in response to said cipher using said first smart card, said decryption key being transmitted from said first smart card to said electronic device (col. 10, lines 26-54; col. 14, lines 12-37);

obtaining a second decryption key in response to said cipher using said second smart card, said second decryption key being transmitted from said second smart card to said electronic device (col. 10, lines 26-54; col. 14, lines 12-37); and

using said first and second decryption keys and a decryption algorithm located on said electronic device to decrypt said digital media content stored on said electronic device (col. 10, lines 26-54; col. 14, lines 12-37).

Tsuria does not disclose sending a request for said digital media content over said network from said electronic device. Spies discloses a method for delivering digital media content, which includes the step of sending a request for digital media content over a network from an electronic device (fig. 10, step 310). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Tsuria method to include the step of sending a request for said digital media content over said

network from said electronic device and use a smart card, as taught by Spies. The request provides the cable company with payment instructions defining how the subscriber desires to pay for the rental program rental (col. 15, lines 42-50).

Tsuria does not disclose that the smart cards are connected in series such that output of one smart card is input of the other smart card. Chaney discloses a method for delivering digital media content implementing a series connection of two smart cards such that output of one smart card is input of the other smart card (fig. 11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Tsuria method to implement a series connection of the two smart cards such that output of one smart card is input of the other smart card, as taught by Chaney. A system processing video data via series connected smart cards can use multiple access-controlled signals to provide features such as picture-in-picture and picture-outside-picture in a video system such as a TV receiver (col. 12, lines 28-39). Accordingly, the second smart card generates a new cipher and sends the new cipher to the first smart card.

b. Regarding claim 16, Tsuria further discloses presenting said digital media content to said user (fig. 2B, element 140).

12. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuria, Chaney and Spies as applied to claim 15 above, and further in view of Digital Audio-Visual Council. Tsuria, Chaney and Spies do not disclose denoting as reference points on said smart card each place in said stream of digital media content where said

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user or each one of a plurality of users has stopped receiving said digital media content. Digital Audio-Visual Council discloses denoting as reference points each place in a stream of digital media content where said user or each one of a plurality of users has stopped receiving said digital media content (p. 31, see Section 8.2.5.2 Functions). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Tsuria, Chaney and Spies to include the step of denoting as reference points each place in said stream of digital media content where said user or each one of a plurality of users has stopped receiving said digital media content, as taught by Digital Audio-Visual Council, in order to provide a time-out whenever a session is temporarily inactive. Accordingly, this session management function is provided by said smart card.

13. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuria in view of Spies.

a. Regarding claim 19, Tsuria discloses a method for delivering digital media content, said method for use with a network, said network interfaced with a storage medium containing digital media content and further interfaced with an electronic device, said electronic device interfaced with a first smart card equipped with a license for said digital media content and further interfaced with a second smart card, said method comprising the steps of:

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receiving a stream of said digital media content in encrypted form from said medium with said electronic device, said encrypted digital media content being stored on said electronic device (figures 2B and 8);

extracting a cipher from said digital media content and sending said cipher to said first smart card (col. 1, lines 43-46; col. 13, line 55 – col. 14, line 3);

obtaining a first decryption key in response to said cipher using said first smart card, said decryption key being transmitted from said first smart card to said electronic device (col. 13, line 55 – col. 14, line 3);

extracting a cipher from said digital media content and sending said cipher to said second smart card (col. 1, lines 43-46; col. 13, line 55 – col. 14, line 3);

obtaining a second decryption key using said second smart card, said second decryption key being transmitted from said second smart card to said electronic device (col. 13, line 55 – col. 14, line 3); and

using said first and second decryption keys and a decryption algorithm located on said electronic device to decrypt said digital media content stored on said electronic device (col. 13, line 55 – col. 14, line 3).

Tsuria does not disclose sending a request for said digital media content over said network from said electronic device. Spies discloses a method for delivering digital media content, which includes the step of sending a request for digital media content over a network from an electronic device (fig. 10, step 310). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Tsuria method to include the step of sending a request for said digital media content over said

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network from said electronic device and use a smart card, as taught by Spies. The request provides the cable company with payment instructions defining how the subscriber desires to pay for the rental program rental (col. 15, lines 42-50).

b. Regarding claim 20, Tsuria further discloses presenting said digital media content to said user (fig. 2B, element 140).

14. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuria in view of Spies as applied to claim 19 above, and further in view of Digital Audio-Visual Council. Tsuria and Spies do not disclose denoting as reference points on said smart card each place in said stream of digital media content where said user or each one of a plurality of users has stopped receiving said digital media content. Digital Audio-Visual Council discloses denoting as reference points each place in a stream of digital media content where said user or each one of a plurality of users has stopped receiving said digital media content (p. 31, see Section 8.2.5.2 Functions). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined method of Tsuria and Spies to include the step of denoting as reference points each place in said stream of digital media content where said user or each one of a plurality of users has stopped receiving said digital media content, as taught by Digital Audio-Visual Council, in order to provide a time-out whenever a session is temporarily inactive. Accordingly, this session management function is provided by said smart card.

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15. Claims 24-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spies as applied to claim 23 above, and further in view of Handelsman. Spies does not disclose that said digital media content is audio, video or text. Handelsman discloses a method for delivering digital media content, which can be audio, video or text (col. 13, lines 22-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the medium of Spies such that said digital media content is audio, video or text, as taught by Handelsman. These digital content types are distributable and storable in electronic form.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gammie et al. (5,237,610) discloses an independent external security module for a digitally upgradeable television signal decoder.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 703-306-5617.

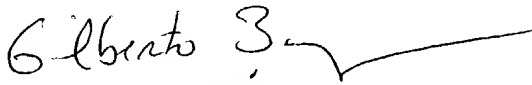
The examiner can normally be reached on Mon - Fri: 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Minh Dinh
Examiner
Art Unit 2132

MD
09/17/2004


GILBERTO BARRÓN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100